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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,290	07/27/2001	Kwok-Shun Cheng	MCA-437PC/US	8923

7590 01/11/2005
Mykrolis Corporation
129 Concord Road
Billerica, MA 01821-4600

EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/890,290	Applicant(s) CHENG ET AL.	
	Examiner Krishnan S Menon	Art Unit 1723	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12/21/04. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-32.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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Attachment to Advisory Action

The after-final amendment submitted by the Applicant on 12/21/04 will not be entered because it contains new matter that raises new issues.

Claim 3 as amended reads that the housing, sealing member and the membrane are all formed ... by thermally induced phase separation. This is new matter because only the membrane is disclosed as formed by thermally induced phase inversion in the specification or claims as originally filed, not the housing and the seal member. The housing and the seal member formed by thermally induced phase inversion raise both new matter and new issue, and require further consideration.

Response to Arguments:

Since the amendment was not entered, the response to the arguments are directed at the rejected pending claims.

(1) Argument that Kawai "teaches away", and that the porous membrane in Kawai is PTFE: First of all, applicants have not elaborated on how Kawai 'teaches away', and what is Kawai teaching away from. Moreover, a reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis.

Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47

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USPQ2d 1516, 1522-23 (Fed. Cir. 1998). With regard to the argument that Kawai uses only PYFE, see col 3 lines 44-52 (this was repeatedly pointed out in prior office actions) wherein it teaches a membrane having perfluoroalkyl polymer, HFP, or TFE-ethylene copolymer, or mixtures thereof. It is granted that the membrane contains PTFE, but it also contains the other thermoplastic polymers, which makes the reference anticipatory. Applicant's claims are open-ended, and do not preclude PTFE as membrane material. If applicants were to amend the claims with precluding PTFE and having only thermoplastic perfluoro polymers as membrane materials, the claims would still be unpatentable because there are numerous references which teach membranes with perfluoro-polymers, and the Kawai reference teach the structure and forming the cartridges with thermoplastic perfluoro-polymers for housing and potting.

(2) Applicants' quotation of col 8 lines 8-14: the reference to PTFE in square brackets is misleading; the cited paragraph does not contain PTFE; any implication that it is meant for PTFE alone is only be speculation by the applicant. This paragraph clearly states that the fixing resin (or the sealing resin) must have a temperature not higher than that of the membrane resin. In fact, one of ordinary skill in the art would use the cited paragraph to build a cartridge with a membrane of any material polymer, and do the potting or fixing or sealing with same or similar material polymer having a lower melting point.

(3) Applicants have quoted several lines from the reference to show that the fixing resins taught by the reference have all a temperature less than the melting point of

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PTFE. However, the reference does not stress this point, and this is not an evidence that the reference is only teaching "pure PTFE". The cited paragraph only teaches fixing resins which are at or below the melting point of the membrane material. One of ordinary skill in the art could quickly pick a combination of sealing resin from the compounds taught by the reference that has the same or lower melting point as that of the membrane material.

(4) In response to applicant's reason that the present amendments were not submitted earlier because the examiner made the first office action after RCE a final rejection: Applicant could have filed the new amendments with the RCE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


W. L. WALKER
SUPERVISORY PATENT EXAMINER
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